



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/127,112	07/31/1998	BRIAN I MARCUS	005	9729

28554 7590 02/08/2002

VIERRA MAGEN MARCUS HARMON & DENIRO LLP  
685 MARKET STREET, SUITE 540  
SAN FRANCISCO, CA 94105

EXAMINER

ROVNAK, JOHN EDMUND

ART UNIT PAPER NUMBER

3713

DATE MAILED: 02/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/127,112

Applicant(s)

MARCUS ET AL.

Examiner

John Rovnak

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 49-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3713

1. Applicant's arguments with respect to claims 49-69 have been considered but are moot in view of the new ground(s) of rejection.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 49, 51, 52, 53, 54, 55, 56, 58, 61, 62, 63, 64, 65, 66 and 67 are rejected under U.S.C. 102(b) as being anticipated by Rando et al. (5,128,520)

3. Rando et al discloses a computer system comprising: a plurality of hand-held objects (14, 24), an object of said plurality of hand-held objects having a unique visual aspect (Fig. 13); a substantially horizontal surface [col. 2 lines 62-64] including at least a section capable of supporting said plurality of hand-held objects; a detecting element proximate to at least said section of said surface (12); a first processor linked to said detecting element [(18); col. 5 lines 17-22; The first processor is inherent in the label data handling system "including decode logic and software for the handling of the decoded data".]; a personal computer [col. 5 lines 20-22: The decoded data is interfaced "with transaction storage at a central processor". Col. 17 lines 28-40 disclose that the information read by the scanner (label data handling system) is passed on to a *PC* (personal) computer attached to the *network*. (Emphasis added)] including: a loading device for loading executable code into said personal computer from an outside source (inherent in the conventional personal computer); a storage device for storing the executable code (inherent in the conventional personal computer); a second

Art Unit: 3713

processor for processing at least the executable code, and an output device for presenting a user interface (both also inherent in the conventional personal computer); a component within said hand-held objects capable of affecting an electrical change in at least a portion of said detecting element (Fig. 12 and 13 – Bar code); at least one of said first and second processors being capable of identifying said visual aspect of said hand-held object as a result of said electrical change.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 50, 57, 60 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rando et al, as discussed above, in view of Tooley (5,252,814). Rando et al does not discuss the use of a wire grid. Tooley, however, teaches the use of digitizer panel that can detect the position of a plurality of objects, said panel comprising a wire grid as can be seen in Fig. 2. It would have been obvious to one of ordinary skill in the art that the Rando et al invention could be modified to include the wire grid of Tooley for position detection of a plurality of items on the horizontal digitizer surface. Use of triangulation is inherent Fig. 2 of Tooley.


6. Claims 59, 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rando et al.

7. Col. 17 lines 34-40 teach the use of a network but don't specify the kind of network. Use of a wireless network would have been conventional knowledge at the

Art Unit: 3713

time of the invention and would have therefore been obvious to one of ordinary skill in the art to incorporate into the Rando et al system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rovnak whose telephone number is (703) 308-3087. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
John Rovnak  
Primary Examiner  
Art Unit 3713

February 5, 2002